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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/218,761	12/22/1998	DIRK NEUBAUER	2338/OE966	2666

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EXAMINER

LEWIS, TISHA D

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/218,761

Applicant(s)

NEUBAUER ET AL.

Examiner

TISHA D. LEWIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☒ Claim(s) 5-10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on March 1, 2004 has been entered.

Information Disclosure Statement

The information disclosure statement filed on March 1, 2004 has been acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 2 is rejected under 35 U.S.C. 102(b) as being unpatentable by GB 1076315. The GB reference discloses a gearbox with an actuating device for automated or semi-automated shifting and selection of a gear ratio having a gearbox operating element (8) arranged to set the ratio and activated by an operating actor (12) having a drive (10, 11) with a drive output (9) which swivels (half turn revolutions in

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clockwise or counterclockwise directions) to carry out a movement to engage a gear ratio or select a shift slot and at the same time acting on a force accumulator (bending of 8 upward or downward) which activates an intermediate element (15) to operate the operating element and being limited by a retaining element (blocking device).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1081707 in view of GB 1076315. The GB (707) reference discloses a gearbox with an actuating device for automated or semi-automated shifting and selection of a gear ratio having a gearbox operating element (21) arranged to set the ratio and activated by an operating actor (17) having a drive (26-29) with a drive output (14) which swivels (half turn revolutions in clockwise or counterclockwise directions) to carry out a movement to engage a gear ratio or select a shift slot and at the same time acting on a force accumulator (pushing of rod 24) which activates an intermediate element (23) to operate the operating element, but this reference does not disclose if a retaining element is used.

The GB (315) reference discloses a gearbox with an actuating device for automated or semi-automated shifting and selection of a gear ratio having a gearbox operating element (8) arranged to set the ratio and activated by an operating actor (12)

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having a drive (10, 11) with a drive output (9) which swivels (half turn revolutions in clockwise or counterclockwise directions) to carry out a movement to engage a gear ratio or select a shift slot and at the same time acting on a force accumulator (bending of 8 upward or downward) which activates an intermediate element (15) to operate the operating element and being limited by a retaining element (blocking device).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the GB (707) reference with a retaining element in view of the GB reference (315) to avoid unintentional movement of the operating element while a gear ratio is engaged.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0301724 in view of GB 1076315. The EP reference discloses a gearbox with an actuating device for automated or semi-automated shifting and selection of a gear ratio having a gearbox operating element (3) arranged to set the ratio and activated by an operating actor (6, 9) having a drive (11, 23) with a drive output (13, 24) which swivels (half turn revolutions in clockwise or counterclockwise directions) to carry out a movement to engage a gear ratio or select a shift slot and at the same time acting on a force accumulator (springs 7, 10) which activates an intermediate element (4, 28) to operate the operating element, but this reference does not disclose if a retaining element is used.

The GB (315) reference discloses a gearbox with an actuating device for automated or semi-automated shifting and selection of a gear ratio having a gearbox operating element (8) arranged to set the ratio and activated by an operating actor (12)

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having a drive (10, 11) with a drive output (9) which swivels (half turn revolutions in clockwise or counterclockwise directions) to carry out a movement to engage a gear ratio or select a shift slot and at the same time acting on a force accumulator (bending of 8 upward or downward) which activates an intermediate element (15) to operate the operating element and being limited by a retaining element (blocking device).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the EP reference with a retaining element in view of the GB reference (315) to avoid unintentional movement of the operating element while a gear ratio is engaged.

As to claims 3 and 4, The EP reference discloses the operating element being a shifting shaft (3) which can be rotated or axially moved to select or engage a gear ratio.

Allowable Subject Matter

Claims 5-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is

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paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
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Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 703-305-0921. The examiner can normally be reached on M-Thur 8 AM TO 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tdl
October 7, 2004


TISHA LEWIS
PRIMARY EXAMINER
Aa 3681 10/7/04